

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Alan D. Ford et al.	Art Unit	: 2125
Serial No.	: 09/877,404	Examiner	: Ryan A. Jarrett
Filed	: June 8, 2001	Conf. No.	: 8082
Title	: AN INFUSION PUMP WITH AN ELECTRONICALLY LOADABLE DRUG LIBRARY AND A USER INTERFACE FOR LOADING THE LIBRARY		

**MAIL STOP AMENDMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**INFORMATION DISCLOSURE STATEMENT**

Applicants request consideration of the references listed on the attached PTO-1449 form. Under 37 C.F.R. § 1.98 (a)(2)(ii), only copies of foreign patent documents and/or non-patent literature are enclosed. Copies of any listed U.S. patents or U.S. patent application publications can be provided upon request.

This Statement provides information relating to applicants' European Patent that corresponds to the present application. European Patent No. 0 649 316 issued on December 20, 2000, and was opposed by two parties (Terumo Corporation and Fresenius Medical Care Deutschland). The patent was initially revoked by the Opposition Division at a hearing on January 27, 2004 based on an asserted lack of novelty. Applicants appealed, and the Technical Board of Appeal set aside the Opposition Division's decision to revoke the patent as to novelty at a hearing on May 9, 2007. The Board of Appeal sent the case back to the Opposition Division to consider the question of inventive step. The hearing date has been set for February 20, 2008.

The attached form PTO-1449 lists all of the references cited in the opposition proceedings, as well as copies of relevant briefs and other correspondence filed by applicants and the two opposing parties. A brief chronology of events (with the corresponding designation IDs from form PTO-1449) and a list of references D1 to D12 cited during the Opposition are included below.

**Chronology of European Opposition No. 93924322.6**

**Patent Issued** (December 20, 2000) (AH on form PTO-1449)

The patent issued with seven claims, of which claims 1 and 3 were independent.

**Notices of Opposition** (September 19, 2001) (AN, AO)

The Oppositions were based on eight main references, D1 to D8. Terumo cited D1-D5 and Fresenius cited D6-D8. Applicants responded citing references D9 and D10 for support. Dictionary citations D11 and D12 were cited to define claim terms. (The D1-D12 reference designations are indicated on Form PTO-1449)

**Opposition Division Preliminary Opinion** (August 5, 2003) (AR)

The preliminary opinion by the Opposition Division was positive and indicated that the patent could be maintained as granted.

**Opposition Division Oral Hearing** (January 27, 2004)

The Opposition Division concluded that claim 1 was anticipated by D1 (Howson, U.S. Patent No. 5,088,981) and the EP patent was revoked. The validity of independent claim 3 was not considered.

**Opposition Division Decision Revoking the EP Patent** (February 25, 2004) (AU)

The Decision summarized the arguments presented at the oral hearing and noted that D1 anticipated claim 1. There was no need to review claim 3, because the patent was to be reviewed as a whole.

**Applicants' Appeal Brief** (July 6, 2004) (AV)

The brief restated applicants' position that independent claims 1 and 3 should be upheld. Applicants also included two Auxiliary Claim Sets.

**Terumo's Response** (January 24, 2005) (AW)

Terumo's response alleged on the anticipation of claim 1 by references D1 and D3 and also alleged the anticipation of claim 3 by references D1, D3, and D6.

**Fresenius Settled with Applicants' Assignee and Withdrew from the Opposition** (March 17, 2005)

**Appeal Board Provisional Opinion** (February 22, 2007) (AX)

The Provisional Opinion does not bind the Board in any way, but focused on references D1, D3, and D6 with respect to novelty of claim 1 (applicants swore behind D6 in their U.S. prosecution).

**Applicant Submitted New Auxiliary Claim Sets** (April 6, 2007) (AY)

**Oral Appeal Hearing** (Wednesday, May 9, 2007, written opinion, July 9, 2007) (ABB)

The Board of Appeal concluded that the new claim 1 of one of the Auxiliary Claim Sets was novel and set aside the decision on appeal. The case will be remitted to the Opposition Division to consider inventive step.

**Summons to Attend Oral Hearing** (July 30, 2007) (ACC)

The Opposition Division has set a hearing date of February 20, 2008.

**Prior Art Cited During EP Opposition**

D1 – Howson et al., U.S. Patent No. 5,088,981 (AD)

D2 – Arthur, III, U.S. Patent No. 4,978,335 (AC)

D3 – Kobayashi, U.S. Patent No. 4,469,481 (AA)

D4 – Crankshaw (Univ. Melbourne), WO 88/10383 (AF)

D5 – Welmed P3000 Syringe Pump brochure (AI)

D6 – Bazaral et al., Biomedical Instrumentation & Tech., 364-370, Sept./Oct. 1992 (AJ)

D7 – Steger et al. (Braun Melsungen AG) EP 0,384,155 (AG)

D8 – Coutré et al., U.S. Patent No. 5,153,827 (AE)

D9 – Crankshaw, U.S. Patent No. 4,741,732 (AB)

D10 – Rodnay Zaks, From Chips to Systems (© 1981, Sybex) (AK)

D11 – Definitions of “library” (Oxford English dictionary and Macmillan dictionary) (AL).

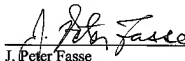
D12 – Definition of “read-only memory” (MacMillan Dictionary of Information Technology) (AM)

This Statement and the accompanying form PTO-1449 are being submitted before a first office action on the merits in this application. No fees are believed due. However, please apply any charges or credits to Deposit Account No. 06-1050, referencing attorney docket no. 00786-157003.

Respectfully submitted,

Date:

August 6, 2007

  
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Substitute Form PTO-1449 (Modified)	U.S. Department of Commerce Patent and Trademark Office	Attorney's Docket No. 00786-157003	Application No. 09/877,404
<b>Information Disclosure Statement by Applicant</b> (Use several sheets if necessary)		Applicant Alan D. Ford et al.	
		Filing Date June 8, 2001	Group Art Unit 2125

(37 CFR §1.98(b))

**U.S. Patent Documents**

Examiner Initial	Desig. ID	Document Number	Publication Date	Patentee	Class	Subclass	Filing Date If Appropriate
	AA	4,469,481	09/04/1984	Kobayashi, Susumu (D3)			
	AB	4,741,732	05/03/1988	Crankshaw et al. (D9)			
	AC	4,978,335	12/18/1992	Arthur, III (D2)			
	AD	5,088,981	02/18/1992	Howsen et al. (D1)			
	AE	5,153,827	10/06/1992	Coutre et al. (D8)			

**Foreign Patent Documents or Published Foreign Patent Applications**

Examiner Initial	Desig. ID	Document Number	Publication Date	Country or Patent Office	Class	Subclass	Translation	
							Yes	No
	AF	WO 88/10383	12/19/1988	WIPO (D4)				
	AG	EP 0384155	01/26/1990	Europe (D7)			X	
	AH	EP 0649316	12/20/2000	Europe				

**Other Documents (include Author, Title, Date, and Place of Publication)**

Examiner Initial	Desig. ID	Document
	AI	Welmed P3000 Syringe Pump; March 1992 (D5)
	AJ	Bazarat et al., Biomedical Instrumentation & Technology, September 1992 (D6)
	AK	Rodnay Zacks, From Chips to Systems (D10)
	AL	Dictionary of Computing, MacMillan Dictionary ("library"), 1986 (D11)
	AM	MacMillan Dictionary of Information Technology ("read-only memory"), December 2003 (D12)
	AN	Notice of Opposition (Terumo Corporation); September 19, 2001
	AO	Translation of Opposition (Fresenius Medical Care); September 19, 2001
	AP	Communication of Notices of Opposition (RULE 57(1) EPC, November 14, 2001)
	AQ	Patentee's Requests; May 24, 2002
	AR	Summons to attend Oral Proceedings pursuant to Rule 71(1) EPC and Preliminary Opinion, August 5, 2003
	AS	Letter from Opponent (Terumo Corporation); December 22, 2003
	AT	Letter from Opponent (Fresenius Medical Care); December 29, 2003 (and translation)
	AU	Decision Revoking the European Patent (Article 102(1), (3) EPC), February 25, 2004

Examiner Signature	Date Considered
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EXAMINER: Initials citation considered. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

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(37 CFR §1.98(b))			

Other Documents (include Author, Title, Date, and Place of Publication)		
Examiner Initial	Desig. ID	Document
	AV	Grounds of Appeal (filed by applicant); July 6, 2004
	AW	Response by Opponent (Terumo); January 24, 2005
	AX	Summons to Oral Proceedings pursuant to Rule 71(1) EPC and Provisional Opinion, February 22, 2007
	AY	Amended Main Request and Auxiliary Requests by Applicant; April 6, 2007
	AZ	Letter from opponent (Terumo); April 23, 2007
	AAA	Minutes of Oral Proceeding; June 1, 2007
	ABB	Decision on Appeal; July 9, 2007
	ACC	Summons to Attend Oral Hearing; July 30, 2007

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